



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 18

KENNETH E. MACKLIN
MILDE, HOFFBERG & MACKLIN
10 BANK STREET
SUITE 460
WHITE PLAINS NY 10606

COPY MAILED

MAY 13 2003

In re Application of
Karsten Brauer, Frank Gansicke, Helmut
Friedrich, and Heinz Fabian
Application No. 08/897,713
Filed: July 21, 1997
Attorney Docket No.: HQ202
Title: PROCESS AND APPARATUS FOR
THE PRODUCTION OF A CYLINDRICAL
COMPONENT OF GLASS

OFFICE OF PETITIONS

DECISION ON PETITION

This is a decision on the renewed petition under 37 CFR 1.137(a)¹ to revive the above-identified application, as well as a petition to withdraw the holding of abandonment pursuant to 37 C.F.R. §1.181(a), both filed together on April 1, 2003.

On August 31, 1998, the Office mailed a non-final Office Action to petitioner. On December 4, 1998, a reply was received. On March 18, 1999, a letter was mailed to the applicant, indicating that the reply was non-responsive, and giving the applicant one (1) month to reply. On April 22, 1999, an amendment was received which contained a certificate of mailing dated April 19, 1999. Again, this amendment was non-responsive, and on June 15, 1999, another letter was mailed to the applicant, indicating that this third attempt was non-responsive, and again giving the applicant one (1) month to reply. The above-identified application became abandoned for failure to reply in a timely manner to this letter of June 15, 1999. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the

¹ A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(l);
- (3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable;
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

above-identified application became abandoned on July 16, 1999. A Notice of Abandonment was mailed on October 1, 1999.

On January 6, 2002, petitioner filed the original petition, which was dismissed via a decision mailed on March 11, 2003, for failure to establish that the delay was unavoidable.

Concerning the petition to withdraw the holding of abandonment, filed under 37 C.F.R. §1.181(a), the petition is dismissed as untimely. MPEP 711.03(c) sets forth that a petition to withdraw the holding of abandonment must be filed within two months of the mail date of the notice of abandonment (October 1, 1999)².

Concerning the renewed petition, the petition lacks item (3) above.

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.137(a).

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner's interpretation of those provisions is entitled to considerable deference."³

"[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts clearly demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked any basis in reason or common sense."⁴

"The court's review of a Commissioner's decision is 'limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.'"⁵

"The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency."⁶

² See also 37 C.F.R. 1.181(f).

³ Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency's interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute."))

⁴ Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

⁵ Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct. 1241, 1244 (1973) (citing 5 U.S.C. 706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir. 1982)).

⁶ Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

The standard

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."⁷

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"⁸

Nonawareness of a PTO rule will not constitute unavoidable delay⁹

The burden of showing the cause of the delay is on the person seeking to revive the application.¹⁰

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action.

The Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and the applicant is bound by the consequences of those actions or inactions¹². Specifically, petitioner's delay caused by the mistakes of negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133¹³.

The actions of the attorney are imputed to the client, for when a petitioner voluntarily chooses an attorney to represent him, the petitioner cannot later distance avoid the repercussions of the actions or inactions of this selected representative, for clients are bound by the acts of their lawyers/agents, and constructively possess "notice of all facts, notice of which can be charged upon the attorney".¹⁴

⁷ Id.

⁸ See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

⁹ See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

¹⁰ Id.

¹¹ See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

¹² Link v. Wabash, 370 U.S. 626, 633-634 (1962).

¹³ Haines, 673 F.Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32; Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 103, 131 (Comm'r Pat. 1891).

¹⁴ Link at 633-634.

"Courts hesitate to punish a client for its lawyer's gross negligence, especially when the lawyer affirmatively misled the client," but "if the client freely chooses counsel, it should be bound to counsel's actions¹⁵."

The portion of the MPEP relevant to the abandonment of this application

MPEP 711.03(c) states, in part:

PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based upon unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.

§ 1.121 Manner of making amendments in application.

- (c) Claims.—
- (1) Amendment by rewriting, directions to cancel or add . Amendments to a claim must be made by rewriting such claim with all changes (e.g., additions, deletions, modifications) included. The rewriting of a claim (with the same number) will be construed as directing the cancellation of the previous version of that claim. A claim may also be canceled by an instruction.
 - (i) A rewritten or newly added claim must be in clean form, that is, without markings to indicate the changes that have been made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added (e.g., "amended," "twice amended," or "new").

¹⁵ *Inryco, Inc. v. Metropolitan Engineering Co., Inc.*, 708 F.2d 1225, 1233 (7th Cir. 1983). See also, *Wei v. State of Hawaii*, 763 F.2d 370, 372 (9th Cir. 1985); *LeBlanc v. I.N.S.*, 715 F.2d 685, 694 (1st Cir. 1983).

- (ii) If a claim is amended by rewriting such claim with the same number, the amendment must be accompanied by another version of the rewritten claim, on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of that claim. A parenthetical expression should follow the claim number indicating the status of the claim, e.g., "amended," "twice amended," etc. The parenthetical expression "amended," "twice amended," etc. should be the same for both the clean version of the claim under paragraph (c)(1)(i) of this section and the marked up version under this paragraph. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added claim or a canceled claim as it is sufficient to state that a particular claim has been added, or canceled.
- (2) A claim canceled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.
- (3) A clean version of the entire set of pending claims may be submitted in a single amendment paper. Such a submission shall be construed as directing the cancellation of all previous versions of any pending claims. A marked up version is required only for claims being changed by the current amendment (see paragraph (c)(1)(ii) of this section). Any claim not accompanied by a marked up version will constitute an assertion that it has not been changed relative to the immediate prior version.

Application of the standard to the current facts and circumstances

In both the original and the renewed petition, petitioner maintains that the circumstances that led to the abandonment of the application meet the aforementioned unavoidable standard and, therefore; petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner contends that this mailing was never received.

With the renewed petition, Petitioner has set forth that two consecutively mailed pieces of correspondence were not received by the applicant. Petitioner discusses a probability of correlated errors and an impediment to delivery, but this is mere speculation, and does not amount to the sort of documentary evidence which would lead the Office to determine that the abandonment of this application was unavoidable.

Petitioner asserts that he does indeed maintain a log of correspondence of all mail received from the Office. Petitioner describes this system as consisting of an index card associated with each file, an electronic system, and a notation on the face of the file wrapper.

Petitioner describes the electronic system as a "sequential entry system,¹⁶" meaning that as correspondence is received, it is entered into the computer.

Petitioner has included a print-out of this electronic system, which contains all mail received on the following dates:

- April 13, 1999 – April 15, 1999
- June 9, 1999 – June 12, 1999
- June 23, 1999 – June 25, 1999
- July 8, 1999 – July 10, 1999
- July 14, 1999 - July 15, 1999
- August 25, 1999 - August 26, 1999

Petitioner adds "the sheets provided are the only sheets now known to exist for this date range. Presumably, the relevant docket entry should have appeared on the 6/23/99, and/or 7/14/99

¹⁶ Petition, page 5.

docket sheets...a search has been conducted, and no such back-up or paper copy is known to exist. The firm has no formal policy on maintaining such sheets, especially from so long ago¹⁷."

The correspondence at issue was mailed from Northern Virginia to New York State on June 15, 1999. Unfortunately, it does not appear that petitioner will be able to make the required showing of non-receipt in that this record is incomplete, as the report does not show all articles of mail received during the relevant time period. This report establishes that that the piece of correspondence at issue was not received during the periods set forth above¹⁸. It cannot establish that a piece of correspondence was not received on a date which is not shown above. For instance, if the article of mail took from three to five days to travel from Northern Virginia to White Plains, New York, it would not appear on the listing Petitioner has provided, as the period of June 18, 1999 – June 20, 1999 is not represented.

Petitioner adds that maintaining a list of received correspondence would not provide any "particular workflow benefit, failsafe backup, or efficiency, and would therefore only be of value in such rare instances as are now presented." Petitioner is correct, as if he were able to provide evidence that the article of mail was not received, his chances of being able to submit a grantable petition would be greatly increased.

Petitioner adds "it is believed that there is no requirement for a consolidated and persistent mail log, and any such requirement might be considered an abuse of discretion and fail to meet OMB guidelines." Petitioner is correct in stating that the Office does not require practitioners to maintain a consolidated and persistent mail log. Practitioners are free to practice their profession without ever creating a mail log, much less maintaining them. However, if a practitioner decides against maintaining a mail log, he does so at his own peril, as this is the only method of establishing non-receipt of a mailing, per the portion of MPEP 711.03(c) reproduced both in this decision and the previous decision¹⁹. Petitioner is reminded that the burden rests on him to establish that the delay was unavoidable²⁰.

Petitioner then states that the copy of the index card submitted with the previous decision evinces that the correspondence was not received, but as set forth in the previous decision:

A docket report is a mail log, recorded by the person who receives all incoming mail. A docket report should show all incoming mail received during the relevant time period, in order to establish that the correspondence at issue was not received, and merely misplaced and filed with another file.

Petitioner has reproduced a section of this portion of the decision on page 6 of the renewed petition, but petitioner has omitted the operative part of the second sentence above: *and merely misplaced and filed with another file*. This portion of the sentence is crucial, since if the article of mail was received and mistakenly filed with another file, it would not appear on this index

17 *Id.*

18 With the obvious exception of the first period, as this date range precedes the date of mailing.

19 More specifically, see the portion which addresses "a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement."

20 MPEP 711.03(c)III(F).

card. As such, the index card cannot serve as evidence of non-receipt, as it is not a docket report, in that it does not show all incoming mail received during the relevant time period.

Petitioner explains that if a response is submitted, or if it is determined that no response is due, the entry is removed from the docketing system. With this revelation, it is determined that the docket print-out is not acceptable, for the following two reasons.

First, the docket print-out is not a mail log. A mail log is a record of items received. Whether a response is due or has been submitted is irrelevant to a record that accurately reflects all correspondence received during a particular time period. As such, this listing is a "to-do" list rather than a mail log, and hence, even if the record showed all relevant dates, it would not be acceptable as a record of all incoming mail.

Secondly, if entries in the record are deleted after a response is sent or if it is determined that no response is due, this negates the record's ability to confirm that an article of mail was or was not received. Once a member of the office staff deletes an entry, the record would provide to a later observer a false indication that the article of mail was never received.

For these reasons, the showing in the renewed petition is not sufficient to constitute unavoidable delay, and the renewed petition under 37 C.F.R. §1.137(a) is **DISMISSED**.

In the previous decision, it was noted that the period of time which elapsed between the abandonment of this application and the filing of the original petition amounted to 3 ½ years. The impact of this time period on the diligence exhibited by petitioner need not be addressed, as Petitioner has not shown the abandonment to be unavoidable.

Any request for reconsideration or petition under 37 CFR 1.137(a) must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extension of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Second Renewed Petition Under 37 CFR 1.137(a)". This is not a final agency action within the meaning of 5 U.S.C 704.

NOTICE:

Any request for reconsideration of this decision under 37 C.F.R. § 1.137(b) must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. Failure to respond will result in abandonment of the application. The request for reconsideration should include a cover letter entitled "Second Renewed Petition under 37 C.F.R. §1.137(b)," and should only address the deficiencies noted in this decision.

Thereafter, there will be no further reconsideration of this matter.^{21,22}

²¹ For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Louden, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b) ²³.

The reply to this letter may be submitted by mail²⁴, hand-delivery²⁵, or facsimile²⁶.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011.



Paul Shanoski
Attorney
Office of Petitions
United States Patent and Trademark Office

reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R. §§1.181, 182, 183.

22 If, on the second request for reconsideration, Petitioner fails to satisfy the showings burden required: (a) the resulting decision may be one viewed as final agency action; and (b) provisions for reconsideration, such as those at 37 C.F.R. §1.137(e), will not apply to that decision.

23 A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

24 Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1460, Alexandria, VA 22313-1460. Note that this is a new address, as the USPTO has changed addresses as of May 1, 2003.

25 Office of Petitions, 2201 South Clark Place, Crystal Plaza 4, Suite 3C23, Arlington, VA 22202.

26 (703) 308-6916, Attn: Office of Petitions.